

**RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 2100**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named
Inventor : Kevin I. Bertness

Appln. No.: 10/681,666

Filed : October 8, 2003

For : ELECTRONIC BATTERY TESTER WITH
PROBE LIGHT

Docket No.: C382.12-0169

Group Art Unit: 2838

Examiner:

Edward H Tso

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant respectfully requests Pre-Appeal Brief Review of the rejection of claims 1, 4-18 and 20-30 under ¶103(a), based on Bertness (US 6,316,914), in view of Vinci, U.S. Patent No. 5,672,964, since the rejection is based on clear error of fact and omission of essential elements to establish a prima facie rejection. The rejection is unsupported by the cited art.

ARGUMENT

On Page 2 of the final Office Action, claims 1, 4-18 and 20-30 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bertness, in view of Vinci. This rejection was addressed in an Amendment that was filed on June 22, 2007 and in a Response After Final that was filed on November 26, 2007.

In an Advisory Action that was mailed on December 14, 2007, the Examiner states that while the reference (Vinci) does not use a cord-like tip, it still teaches the light being placed by its tip to light the “working area.”

Applicant respectfully points out that, while Vinci, which includes an illumination source attached to a tester housing, may be suitable for lighting a general “working area,” it would be unsuitable for addressing illumination problems in battery testing applications, which the

claimed invention addresses by using a probe light that couples to Kelvin connections instead of an illumination source coupled to a tester housing.

As indicated in column 4, lines 36-41, the device of Vinci includes:

“housing 12 which . . . includes means for mounting an internally threaded socket 22 adapted to interchangeably receive an elongate test probe needle 24 or other accessory (e.g. prods, probes clips or other items used for testing).” (Emphasis Added.)

Nothing in Vinci teaches or suggests coupling a light to the above-listed items used for testing (denoted by reference numeral 24 in Vinci). Any source of illumination in Vinci is attached to housing 12 (see column 5, lines 9-10) and not coupled to an item used for testing.

Page 11, lines 18-27, of the Applicant’s specification, which are included below, describe the particular problem associated with battery testing that the claimed invention addresses.

“In general, when required, separate lighting equipment such as a torch is utilized to illuminate a battery environment during battery testing. However, employing separate lighting equipment during battery testing makes the testing and lighting equipment difficult to properly position and operate in a constrained and poorly lit environment associated with, for example, testing of batteries wherein the battery terminals are recessed in cabinets.” (Emphasis Added.)

Vinci, which includes an illumination source attached to the tester housing, is incapable of addressing the above problem which, to be properly addressed, would at a minimum require a light coupled to an element that directly connects to the battery terminal. Accordingly, claim 1 includes “a probe light configured to couple to at least one of the first and second Kelvin connections, the probe light having a longitudinal axis that is oriented generally toward an end, of one of the first and second Kelvin connections, that couples to one of the first and second terminals of the battery.” Neither Vinci or Bertness, taken individually or in combination, show or suggest this element of claim 1.

Further, combining Bertness (which includes a battery tester without a source of illumination) with Vinci (which, as noted above, includes an illumination source attached to the

tester housing) would result in a battery tester with a source of illumination integrated with its housing and not coupled to its Kelvin connections.

The Office Action additionally suggests that it would have been obvious to have integrated the light onto the Kelvin connection, since it has been held, in *In re Larson*, that the use of one piece construction instead of two or more pieces would be merely a matter of obvious engineering choice.

Applicant respectfully points out that the above conclusion is incorrect because the holding in *In re Larson* is not applicable if the claimed invention eliminates a need, perceived by the prior art, that arises out of using separate components instead of a unitary structure. As noted earlier, claim 1 eliminates a need, perceived by the prior art, for positioning separate lighting equipment while operating a battery tester and therefore the holding in *In re Larson* does not apply to claim 1.

Section 2144.04 of the Manual of Patent Examining Procedure (MPEP) includes, under a sub-section related to making integral, the following:

“*In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (. . . ‘the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice.’); **but** see *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983) (Claims were directed to a vibratory testing machine . . . comprising a holding structure, a base structure, and a supporting means which form ‘a single integral and gaplessly continuous piece.’ Nortron argued that the invention is just making integral what had been made in four bolted pieces. The court found this argument unpersuasive and held that the claims were patentable because the prior art perceived a need for mechanisms to dampen resonance, whereas the inventor eliminated the need for dampening via the one-piece gapless support structure . . .).” (Emphasis Added.)

As can be seen in the underlined language above, in *Schenck*, attaching multiple pieces by bolting the pieces together was already known. In *Schenck*, the claimed invention simply integrates pieces, which could already be attached, into a continuous piece. Yet, the Court in *Schenck* focused, not on the combining of multiple pieces, but on a need to dampen resonance,

perceived by the prior art, that the claimed invention eliminated. Accordingly, the Court in *Schenck* held that *In re Larson* is not applicable if the claimed invention eliminates a need, perceived by the prior art, which arises out of using separate components instead of a unitary structure. Claim 1, in a manner akin to the invention described in *Schenck*, eliminates a need, perceived by the prior art, for positioning additional lighting equipment while operating a battery tester.

Integrating the lighting equipment with at least one Kelvin connection of a battery tester, in accordance with the invention of claim 1, eliminates the need for positioning the lighting equipment described on page 11, lines 18-27 of the Applicant's specification, which are included above. Specifically, "the probe light having a longitudinal axis that is oriented generally toward an end, of one of the first and second Kelvin connections, that couples to one of the first and second terminals of the battery," as required by claim 1, eliminates any need for properly positioning separate lighting equipment. The presence of another invention, such as Vinci, that address a general illumination problem does not in any way make *In re Larson* applicable to the claimed invention. Thus, claim 1 is allowable based on the above MPEP section.

Independent claim 25 has elements similar to that of independent claim 1. Thus, for the same reasons as independent claim 1, Applicant submits that independent claim 25 is allowable as well.

Applicant respectfully points out that the Office Action has not addressed the dependent claims. In general, the dependent claims set forth numerous elements not shown or suggested in the cited references. For example, claim 6, which depends from claim 1, features "the probe light is configured to couple to the at least one of the first and second Kelvin connections via probe extensions." Nothing in the cited prior art teaches or suggests anything about a probe light coupling to Kelvin connections via probe extensions.

In view of the foregoing, and for reasons included in the Amendment filed on June 22, 2007 and in a Response After Final that was filed on November 26, 2007, Applicant respectfully requests reconsideration and allowance of claims 1, 4-18 and 20-30. Favorable action upon all claims is solicited.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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